

**TRANSMITTAL LETTER**  
**(General - Patent Pending)**

Docket No.  
**18360**

In Re Application Of: **Elie-Jean J. Raad**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
<b>09/386,506</b>	<b>August 31, 1999</b>	<b>James M. Hannett</b>	<b>23389</b>	<b>2612</b>	<b>Unassigned</b>

Title: **QUICK CHANGE LENS MOUNT**

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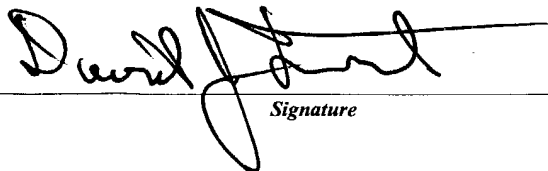
Transmitted herewith is:

**Appellant's Reply Brief Under 37 C.F.R. 1.193(B)(1)**  
**Amendment to Appellant's Brief**

in the above identified application.

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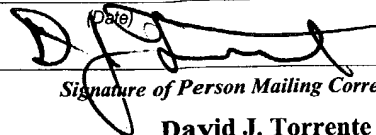
  
Signature

Dated: **November 8, 2004**

**David J. Torrente**  
**Reg. No. 49,099**  
**SCULLY, SCOTT, MURPHY & PRESSER**

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**November 8, 2004**

  
Signature of Person Mailing Correspondence  
**David J. Torrente**

Typed or Printed Name of Person Mailing Correspondence

CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Elie-Jean J. Raad

Examiner: James M. Hannett

Serial No: 09/386,506

Art Unit: 2612

Filed: August 31, 1999

Docket: 18360

For: QUICK CHANGE LENS MOUNT

Dated: November 8, 2004

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AMENDMENT TO APPELLANT'S BRIEF

With respect to the Real Party in Interest in the above-captioned appeal, all right, title and interest in the subject application has been assigned from the inventor, Elie-Jean J. Raad, to Silent Witness Enterprises, Ltd., of Surrey, BC Canada, by virtue of a duly executed assignment, which was recorded 31 August 1999 in the USPTO Assignment Branch at reel 10219, frame 0085.

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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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Dated: November 8, 2004

  
David J. Torrente

Silent Witness Enterprises, Ltd. has subsequently been acquired by, and become a wholly owned subsidiary of, Honeywell International, Inc. Therefore, Appellant hereby requests leave to amend, and so amends, its Appeal Brief, in order to name Honeywell International, Inc., a corporation of Delaware having a place of business at 101 Columbia Road, Morristown, NJ 07962, as the Real Party in Interest.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David J. Torrente", written in a cursive style.

David J. Torrente  
Reg. No. 49,099

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530

DJT:nf



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Elie-Jean J. Raad

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**APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. §1.193(b)(1)**

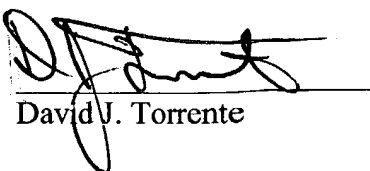
This Reply Brief is responsive to the Examiner's Answer, mailed 08 September 2004 in the above-captioned application. Appellant continues to request an oral hearing.

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.193(b)(1)**

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Dated: November 8, 2004

  
David J. Torrente

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the references. *See, In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). In this regard, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). In the instant appeal, the rationale set forth to support of the combination of Weng, Tanaka, and Palmer must fail because it is internally inconsistent. Moreover, assuming *arguendo* that one of ordinary skill in the art were motivated to combine the references, they would still not arrive at the claimed invention.

It has already been made clear that a quick connect coupling, as used in the specification and as understood by one skilled in the art, does not encompass a simple threaded coupling. The Examiner's Answer cites no evidence to support its asserted position to the contrary, nor to overcome the evidence set forth in Appellant's Brief. The fact that the Examiner's Answer relies on Tanaka at all is further evidence that Weng does not teach or suggest any form of quick connect coupling.

Furthermore, as already made clear in Appellant's Brief, the bayonet style coupling is distinguished from the structure recited in the claim. Contrary to the Examiner's assertion, Tanaka lacks any keyways extending circumferentially from ends of corresponding slots. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The Examiner's Answer relies on Tanaka (Fig. 12) for its teaching of a lens mounting (LE''), which is coupled to a camera body (CA') by the interface of three arcuate projection pawls (35a-c) located on the lens mounting (LE''), with projection pawls (29d-f) located on the camera body (CA'). This structure is offered as reading on the claimed slots and keyways in the base of claim 1. However, the Examiner's answer explicitly acknowledges, as it must, that this proposed combination still does not reach the claimed invention. The Examiner's Answer notes that the alleged combination of Weng and Tanaka lacks the ability to connect threaded lenses to the base. This is where its reasoning fails. Weng was capable of accepting a treaded lens before modification by the alleged combination with Tanaka. Therefore, having defeated this ability in Weng, the Examiner looks to Palmer to overcome this deficiency. It is pure sophistry to suggest that one skilled in the art, having no knowledge of the claimed invention, would substitute the coupling of Tanaka for that of Weng, then look to yet another reference to restore the coupling ability which was just defeated.

The Examiner's Answer looks to Palmer because it admits that the combination Weng and Tanaka does not meet the claimed invention. Specifically, even if combinable, Weng and Tanaka do not teach a removable adapter coupled to the lens assembly. Palmer discloses, in a night vision assembly, an afocal magnifying lens assemble is coupled to the night vision assembly utilizing two adapter rings (30, 31). See, Palmer, Col. 4, lines 18-20. Each of the adapter rings (30, 31) connects to adjacent parts by threaded connections, not quick connect couplings as recited in the claims. The Examiner's Answer alleges that it would have been obvious to replace one, and only one,

threaded coupling of Palmer with the projection pawls taught by Tanaka, in order to reach the claimed invention.

The rejection presumes that an artisan of ordinary skill, without hindsight knowledge of the claimed invention, and faced with the Weng, Tanaka and Palmer references would have been motivated to appropriate one, and only one, of two adapter rings taught by Palmer; to replace one, and only one, of two threaded couplings of that ring, arbitrarily the threaded coupling to interface the base rather than the lens, with the pawl structure taught by Tanaka; and incorporate these features into Weng. However, presuming a skilled artisan were so motivated, without the benefit of hindsight, to replace the threaded couplings of Palmer with the pawls of Tanaka, she would have done so for all threaded couplings, not merely the specific one necessary to meet the present claim. The logical extension of the Examiner's reasoning leads to a structure that does not read on the recited claim. "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (quoting from *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998)).

In fact, Palmer teaches that the afocal lens assembly (20) may have a bayonet connection (Col. 5, lines 38-40), which will be understood by those skilled in the art as similar to the pawl structure of Tanaka, also provided on the lens assembly (LE'). Therefore, Tanaka adds nothing not already disclosed by Palmer. Moreover, the adapter

ring (30) would not have a threaded interior opening to receive a threaded end of a lens housing, and a base insert end having keys for engagement with the base, as recited in the claim. To the contrary, the adapter ring of Palmer would have interior pawls for receiving the bayonet end of the lens, and an exterior threaded end for engagement with the base, precisely the opposite of the claimed invention.

For at least the foregoing reasons, Appellant respectfully submits that claim 1 is patentably distinguished over the cited references.

Turning to method claim 9, the Examiner's Answer relies on similarly flawed reasoning, already obviated above, to apply the alleged combination of Weng, Tanaka and Palmer. Specifically, with respect to step (a), it has already been shown that the alleged combination would not result in attaching a removable adapter having a threaded opening with threads that mate with threads on a lens assembly and a pair of keys at an opposite end thereof. An ordinarily skilled artisan cannot choose from the unknown. See, *In re Ochai*, 71 F3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995). Therefore, Appellant respectfully submits that claim 9 is similarly distinguished over the prior art.



In light of the foregoing, Appellant respectfully submits that all claims recite patentable subject matter, and kindly solicits the Board to REVERSE the Examiner's rejections, and remand with instructions to allow the claims.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "David J. Torrente", with a stylized flourish at the end.

David J. Torrente  
Reg. No. 49,009

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530

DJT:nf